IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Fishman, Daniel	Atty Docket:	2857/105
Serial No.:	09/871,990	Art Unit:	2173
Date Filed:	May 31, 2001	Examiner:	Bonshock
Invention:	**System and Method for Transferring Web-Based Information**	Date:	September 14, 2006

CERTIFICATE OF MAILING

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APPEAL BRIEF

Pursuant to the Notice of Appeal filed April 28, 2006 and the Notice of Panel Decision from Pre-Appeal Brief Review issued August 14, 2006, Applicant submits this Appeal Brief in response to the final rejection of January 30, 2006.

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Real Party in Interest

The assignee of record Palm, Inc. split into two entities, PalmOne, Inc. and PalmSource, Inc. PalmOne, Inc. has changed its name to Palm, Inc. It is the understanding of counsel that PalmSource, Inc. is the intended real party in interest.

Related Appeals and Interferences

None.

Status of Claims

Applicant appeals the final rejection of pending claims 1-6, 8, 9, 11-16, 23 and 33. All other claims have been cancelled.

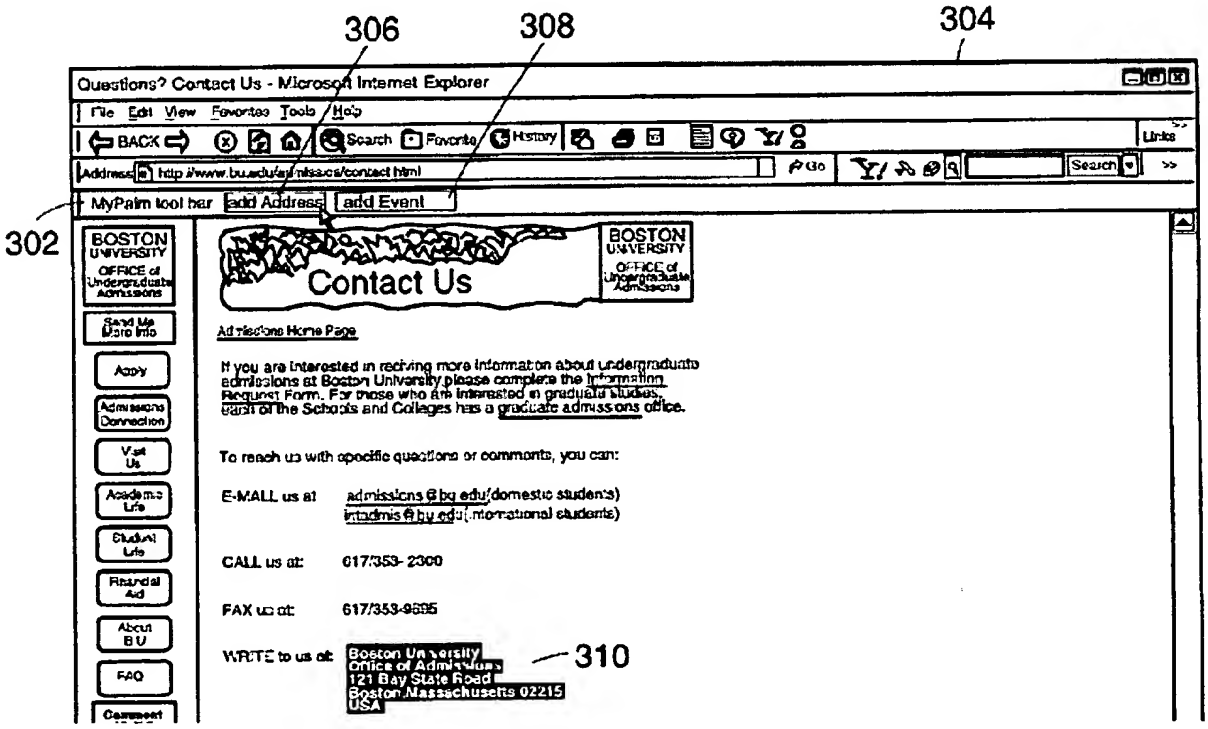
Status of Amendments

No amendments have been filed subsequent to the final rejection of January 30, 2006.

Summary of Claimed Subject Matter

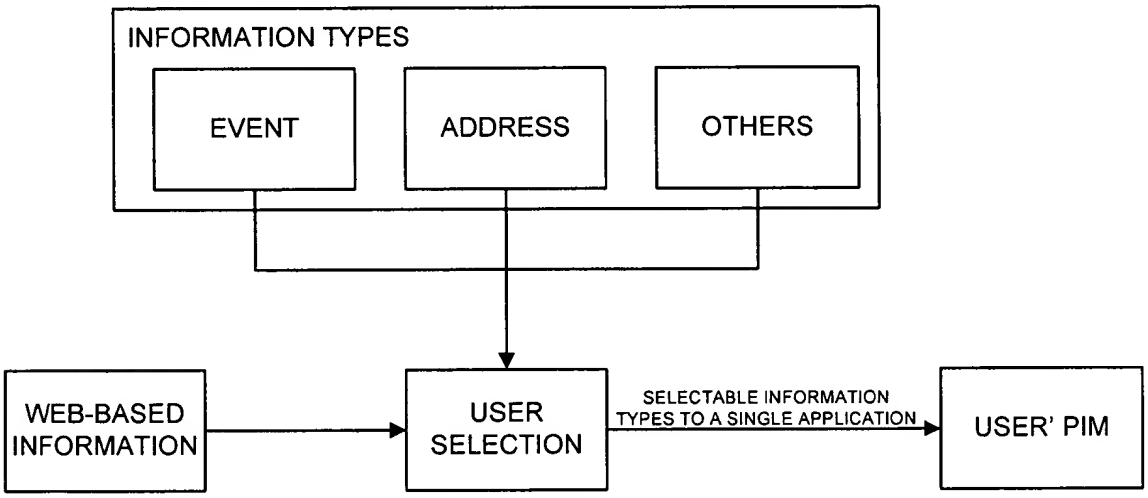
Independent Claim 1 is directed to a method for transferring Web-based information over a network to a personal information management (PIM) system having calendar and contact data for a set of users. Claim 1 in part requires "identifying an information type ... selectable from a group including address and event." As a whole, claim 1 requires sending information to a given application based on a user-selected type of information – e.g., address or event. Independent Claim 11 is a system claim similar in substance to method claim 1. There are no means plus function elements in any of the appealed claims, and the requirements of 35 U.S.C. 112, sixth paragraph are not at issue.

Figures 1-5 of the present application illustrate an embodiment of the claimed invention. Figure 3 and its related discussion in paragraphs [0026] and [0027] (page 6, line 25 to page 7, line 17) are especially relevant. Fig. 3 shows an exemplary Web browser including a toolbar for transferring Web-based information in accordance with an embodiment of the invention. A user can search and view information on the Internet using a Web browser 304 which contains a special toolbar for transferring information from web pages to the user's PIM application. Toolbar 302 includes an add address link 306 and an add event link 308 to add information selected by the user, either an event or an address, to calendar and contact data in the user PIM:



As shown in Figure 3, a user has selected contact information 310 from a Web page. The information type, either address or event, to be transferred to the PIM is selected by the user. The user may select the add address link 306, to transfer this address information to the user's contact data in the user's PIM. Alternatively, the user may select the add event link 308 when adding event information to add the event to the user's calendar data in the user's PIM. The add address link or the add event link causes a transfer request to be created 104 (Fig. 1) that includes the Web-based information ([0027] p. 7, lines 3-4). The transfer request may also include an address of a server associated with the PIM ([0027] p. 7, lines 5-6). The transfer request is sent to the server having access to the calendar and contact data for the users ([0021] p. 4, line 31-p.5, line 3). The information is stored in association with at least one user ([0003] p. 1, lines 25-27; [0021] p. 5, lines 3-5). Specifically as to claim 1, information is stored in accordance with the information type that had been selected (e.g., [0007] p. 2, lines 27-28).

The described embodiment and the claim language can be represented by the following simple illustration:



Grounds of Rejection to be Reviewed on Appeal

Whether claims 1-6, 8, 9, 11-16, 23 and 33 are patentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,339,795 (Narurkar).

Argument

The claims are directed to a method and system for transferring various distinct types of Web-based information to a single specific application—a personal information management system (PIM). The closest prior art, Narurkar, is different. It teaches transferring Web-based information to various distinct user-selectable applications. Narurkar teaches automatically parsing the information in a process transparent to the user. The present invention, as claimed, provides the user with a toolbar from which the user can and must select the information type.

Claims 1 and 11, the only independent claims, are directed to a method and system by which a user selects web-based information and sends it to a personal information management system that applies to a set of users. Claims 1 and 11 in part require a "toolbar having a plurality of indicators for identifying an information type ... selectable from a group including address and event." The user selection of an information type— e.g., address or event— is critical to the creation of the transfer request that will take the information to the server. In the claimed invention, the user makes an information type selection for information to be sent to a PIM. By contrast, Narurkar describes sending specifically address information and allowing the user to select a particular application from a group of multiple different applications which will receive the information. In the Narurkar prior art, the user selects an application to which information is sent. The Narurkar prior art does not disclose or suggest the convenient toolbar offering the information type selection. Indeed, Narurkar utterly lacks user selection of information type.

Paragraph 9 of the Office action states that Narurkar teaches web-based information transfer to a personal information management (PIM) system. And the Examiner relies on a dictionary definition of a PIM to fill in more information than is stated by Narurkar itself, that is that PIMs contain both appointment and address book information. While the Examiner's statements are accurate as to a definition of a PIM, they are incomplete because they fail to characterize the narrow focus of the Narurkar reference. Narurkar explicitly states that: "More specifically, the present invention relates to a user transparent process for exchanging and routing data representing postal address information between disparate data hosts." *Col. 1, lines 20-23.* Narurkar focuses solely on

address (contact) functionality. Thus, Narurkar does not disclose and has no need for a user selection mechanism to distinguish between information types.

Nor would one of ordinary skill in the art be motivated to alter Narurkar to provide an information type selection mechanism as required by the claims. First of all, such a mechanism would impermissibly alter the fundamental principle of Narurkar. The MPEP does not permit an obviousness rejection which acts in this way to alter the fundamental principle of the reference: "THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE." *MPEP* §2143.01.

The principle behind Narurkar is user transparency, involving automatic processing of a user's information transfer request, wherein user selection of information type would be anathema. Narurkar states that "the present invention relates to a user transparent process for exchanging and routing data." *Col. 1, lines 20-22; see also, col. 3, lines 28-29, 34-35, and 42-43:* "What is needed is a process for user-transparent exchange of data..." If in addition to selecting the destination application as taught by Narurkar, the user also had to select a type of information to transfer, then the process as a whole would no longer be "user-transparent" as Narurkar repeatedly insists.

In fact, Narurkar explains at great length his automatic process (non-user controlled) for parsing data (*see col. 18 line 5-col. 19, line 37*), which describes parsing of input data against various pattern matching databases to automatically determine the tags or fields corresponding to information being input by the user (such parsing being the "user-transparent" process Narurkar refers to). And the sole paragraph within Narurkar that in any way mentions any notion of "date" (*col. 22, lines 35-53*) is described as part of Fig. 11C, "a flow diagram ... illustrating further steps of the address data parsing process...." *Col. 22, lines 13-14.* And again, this process is described as being a user-transparent automatic process rather than a user-directed, user selection of information type as is required by the claims.

The examiner cited to col. 3, lines 15-27 of Narurkar as "providing information type by a manual mapping." The passage cited by the examiner, however, is from the Background and describes prior art, not Narurkar's solution. More importantly, the mapping described is for structured data already associated with specific data fields in the source. The individual data fields in the source identify the data, so that further user

selection of information type is superfluous. Manual mapping further cannot be combined with Narurkar's teachings because Narurkar expressly rejected that approach:

> "This method is not transparent to the user because it places a burden of defining a mapping model for data translation on the user of the data hosts.
>
> What is needed is a process for user-transparent exchange of data between disparate data hosts running on disparate computer platforms including hand held computers, desk top computers, and web servers, wherein the process provides automatic mapping between fields of a source data host and corresponding fields of a destination data host."
> *Col. 3, lines 25-33.*

While Narurkar discloses a toolbar with icons, there is absolutely no disclosure of an information type selection mechanism. The examiner refers to column 12, lines 18-40, which provides not even the slightest suggestion of "allowing the user to specify the type of information" as argued by the Examiner. Instead, this section of Narurkar allows a user to make a driver interface module treat a pre-designated home phone number as a main phone. Narurkar also discloses allowing a user to select a database file from within a database. The discussion merely relates to specifying settings for a driver interface module. There is no discussion of allowing a user to associate an information type with Web-based information.

As for column 9, lines 2-6, Narurkar merely discloses the ability to select a destination host. As set forth above, whereas the claimed invention relates to transferring information to a given personal information management system, Narurkar transfers information to a selected one of a plurality of application programs (one of which might be a personal information management system). Narurkar provides no disclosure, suggestion or teaching of user selection of an information type. The parsing of information is done automatically and transparently by Narurkar.

The Examiner argues that selection of an application program amounts to selection of information type. However, in Narurkar, when a user selects an application program to receive information— a destination such as WORD or EXCEL or a PIM—the data being transferred has not been identified as address information or event information. These programs can accept either type of information among others. The claimed invention allows and requires the user to select information type for organizing

proper storage of the information for use by the personal information management system. Selection of an application program, as described in Narurkar, does not identify information type.

Narurkar teaches the transfer of address-based data. Narurkar fails to distinguish between address information and event information. The claims specifically require the ability of the user to select between address information and event information. Although different destination applications may use different data formats, for example a .doc format for WORD or an .xls format for EXCEL, these format differences are irrelevant to the claim, which requires the user to have the ability to select between address information and event information.

The Examiner argues that Narurkar discloses transfer of information to a PIM and that a PIM contains appointment and address book information. But Narurkar does not teach or suggest the claimed invention. Narurkar allows a user to select a particular application, such as a PIM, to which information is to be transferred. There is no suggestion in Narurkar of a user's ability to select an information type such as between address or event for information transferred to the PIM, as required by the claim language. The rejection should therefore be reversed and the claims allowed.

Claims 1 and 11 further contain limitations that make the information type selection a condition to the creation of a transfer request. The claimed request is not made without the information type selection. Claim 1 recites "such request being created in response to such type identification." Claim 11 requires "a transfer request...based on the information type selected by the user." In both claims the information type identification is a condition precedent to creation of the transfer request.

No such requirement is present or disclosed by Narurkar. Narurkar describes transferring data from a source to a destination host. But the process described by Narurkar makes no mention of first requiring user selection of an information type from among types, including address and event. For this additional reason, all claims should be allowed.

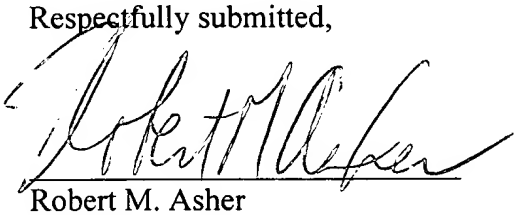
Claim 1 and hence, claims 2-6, 8, 9, 23 and 33 depending therefrom, have a further limitation not disclosed or suggested by Narurkar. According to claim 1, Web-based information is stored on the server "in accordance with the type identification."

Narurkar may store information in accordance with pre-tagged fields or according to the results of his automatic pattern matching. There is no disclosure, suggestion or teaching of storing in accordance with an information type selected by the user from a toolbar associated with the Web browser. For this additional reason, claim 1 and all claims depending therefrom should be allowed.

For all the foregoing reasons, Applicant submits that all claims in the application are allowable over the art of record and early notice to that effect is respectfully solicited.

DATE: September 14, 2006

Respectfully submitted,



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Claims Appendix

1. A method for transferring Web-based information over a network to a personal information management system having calendar and contact data for a set of users, the method comprising:

permitting a user to select the Web-based information on a Web page viewable in a Web browser;

permitting the user to use a toolbar associated with the Web browser, the toolbar having a plurality of indicators for identifying an information type such type being selectable from a group including address and event, associated with the Web-based information so that the user can make an identification of the information type;

receiving the user's identification made via the toolbar of the type of information;

creating a transfer request that includes at least the Web-based information and an address for a server associated with the personal information management system and in communication with the network, such request being created in response to such type identification;

sending the transfer request to the server, the server having access to the calendar and contact data for the set of users; and

storing the Web-based information at the server, the Web-based information associated with at least one user in the set of users, in accordance with the type identification.

2. A method according to claim 1, wherein the transfer request is a hypertext transfer protocol request.

3. A method according to claim 1, wherein the Web-based information is stored in a database in communication with the server.

4. A method according to claim 1, wherein the network is the Internet.

5. A method according to claim 1, wherein the Web-based information is contact information and the Web-based information is stored with the contact data for the at least one user.

6. A method according to claim 2, wherein the Web-based information is event information and the Web-based information is stored with the calendar data for the at least one user.

7. (canceled)

8. The method according to claim 1, further including sending a response from the server to the Web browser to indicate that the Web-based information has been transferred to the personal information management system.

9. A method according to claim 1, wherein the Web-based information is selected by the user by highlighting information displayed by the Web browser.

10. (canceled)

11. A system for transferring Web-based information over a network to a personal information management system having calendar and contact data for a set of users, the system comprising:

a first process running on a server responsive to user interaction;

a Web browser in communication with the first process over the network, wherein the Web browser permits a user to select the Web-based information on a Web page viewable in the web browser;

a toolbar associated with the Web browser, the toolbar having a plurality of indicators for identifying an information type, such type being selectable from a group including address and event, associated with the Web-based information, the toolbar permitting the user to make an identification of the information type; such first process receiving the user's identification made with the toolbar of the type of information;

a second process in communication with the first process, for creating a transfer request that directs the Web-based information to the personal information management system based on the information type selected by the user;

a third process, in communication with the second process, for sending the transfer request to a server; and

at least one server, coupled to the network, to receive the transfer request and store the selected Web-based information, in a storage location associated with the user.

12. A system according to claim 11, wherein the transfer request is a hypertext transfer protocol request.

13. A system according to claim 11, wherein the Web-based information is stored in a database in communication with the at least one server.

14. A system according to claim 11, wherein the Web-based information is contact information and the set of Web-based information is stored with the contact data for the user.

15. A system according to claim 11, wherein the Web-based information is an event and the Web-based information is stored with the calendar data for the user.

16. A system according to claim 11, wherein the Web-based information is selected by highlighting information displayed by the browser.

17.-22. (canceled)

23. A method of according to claim 8, further including presenting a confirming indicator on the toolbar, the confirming indicator confirming transfer of Web-based information to the personal information management system.

24.-32. (canceled)

33. A method according to claim 1, wherein user-interaction with one of the selected indicators also initiates transfer of the Web-based information.

Evidence Appendix

None.

Related Proceedings Appendix

None.